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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,513	11/13/2000	Fuyuki Inui	Q61694	4494

7590

08/25/2004

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EXAMINER

MILIA, MARK R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/709,513

Applicant(s)

INUI, FUYUKI

Examiner

Mark R. Milia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "high" in claims 5 and 17 is a relative term which renders the claim indefinite. The term "high" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear as to how many times the designated contents need to be printed for it to have a "high" frequency of being printed.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6-13, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by JP Patent Application Publication No. 09298720 to Shidara.

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Examiner will refer to a translation of above stated document which is hereby attached.

Regarding claims 1 and 13, Shidara discloses a printing apparatus and method for printing out contents carried on broadcast signals onto paper, comprising a receiving unit for receiving the broadcast signals including contents (see paragraph 9, paragraph 17 lines 3-7, and paragraph 50), a detecting unit for detecting contents designated for printing from the contents received by said receiving unit (see paragraph 9, paragraph 17 lines 3-7, paragraph 33 lines 1-2, and paragraph 51), and a printing unit for printing out said designated contents detected by said detecting unit onto the paper (see paragraphs 19, 34, and 52).

Regarding claims 6 and 18, Shidara discloses the system as discussed above in claims 1 and 13, and further discloses wherein the printing apparatus prints out said designated contents and information relating to said designated contents, onto the paper (see paragraphs 19, 34, and 52).

Regarding claims 7 and 19, Shidara discloses the system as discussed above in claims 1 and 13, and further discloses wherein said detecting unit detects whether or not a signal for print designation is carried on a vertical blanking interval of the broadcast signals (see paragraph 39 lines 1-3 and paragraph 40).

Regarding claim 8, Shidara discloses the system as discussed above in claims 1 and 13, and further discloses a control unit for combining information showing the contents said designated contents in said designated contents wherein said printing unit prints out an image, which is combined by said control

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unit with information showing the contents of said designated contents (see paragraphs 54-55).

Regarding claim 9, Shidara discloses the system as discussed above in claims 1 and 13, and further discloses a storage unit for storing said designated contents detected said detecting unit, and control reading said designated contents stored in said storage unit, instructing a display to display said designated contents (see paragraph 63), and instructing said printing apparatus print selected contents when at least one of the displayed images selected by a user (see paragraphs 66-69 and 71).

Regarding claim 10, Shidara discloses the system as discussed above in claims 1 and 13, and further discloses wherein said storage unit comprises a video tape recording device, which records said designated contents on video tape (see paragraph 56).

Regarding claim 11, Shidara discloses the system as discussed above in claims 1 and 13, and further discloses wherein the broadcast signals are television signals (see paragraphs 16, 27, and 62).

Regarding claim 12, Shidara discloses a broadcast signal generator for generating broadcast signals, comprising a print request signal placing unit for adding to broadcasting data, a signal for requesting a printing apparatus into which the broadcast signals are input, to print designated contents carried on the broadcast signals (see paragraph 16).

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shidara, as applied to claims 1 and 13 above, and further in view of U.S. Patent No. 5488423 to Walkingshaw et al.

Shidara does not disclose expressly a print judging unit for instructing said printing unit to print said designated contents when a print designation code for designating the category of pre-stored designated contents coincides with a category code for specifying the category of said designated contents carried on the broadcast signals.

Walkingshaw discloses a print judging unit for instructing said printing unit to print said designated contents when a print designation code for designating the category of pre-stored designated contents coincides with a category code for specifying the category of said designated contents carried on the broadcast signals (see column 3 lines 31-52 and 59-67, column 4 lines 1-3 and 57-67, and column 5 lines 1-17).

Shidara & Walkingshaw are combinable because they are from the same field of endeavor, printing via a broadcast signal.

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Walkingshaw with the system of Shidara.

The suggestion/motivation for doing so would have been to provide printed data to a user only when parameters set by the user coincide with a particular broadcast thus eliminating printed material not desired by the user.

Therefore, it would have been obvious to combine Walkingshaw with Shidara to obtain the invention as specified in claims 2 and 14.

Claims 3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Shidara and Walkingshaw as applied to claims 2 and 14 above, and further in view of U.S. Patent No. 5940582 to Akabori et al.

Shidara and Walkingshaw do not disclose expressly a quantity detecting unit for detecting the quantity of the paper set in the printing apparatus, and wherein said print judging unit stores therein a plurality of said print designation codes, which are respectively listed in order of priority, and instructs said the priority when the quantity of the paper becomes adequate.

Akabori discloses a quantity detecting unit for detecting the quantity of the paper set in the printing apparatus, and wherein said print judging unit stores therein a plurality of said print designation codes, which are respectively listed in order of priority, and instructs said the priority when the quantity of the paper becomes adequate (see column 2 lines 36-50 and 61-67, column 3 lines 1-47, column 8 lines 45-67, column 9 and column 11 lines 18-33).

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Shidara, Walkingshaw & Akabori are combinable because they are from the same field of endeavor, printing on the basis of desire and priority.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Akabori with the system of Shidara and Walkingshaw.

The suggestion/motivation for doing so would have been to provide a user with documents that are viewed as more desirable before those of less desire. Printing documents in order of priority is well known in the art.

Therefore, it would have been obvious to combine Akabori with Shidara and Walkingshaw to obtain the invention as specified in claims 3 and 15.

Claims 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Shidara and Walkingshaw as applied to claims 2 and 14 above, and further in view of U.S. Patent No. 6747753 to Yamamoto.

Shidara and Walkingshaw do not disclose expressly a quantity detecting unit for detecting the quantity of the paper said printing apparatus; and a storage unit storing data of said designated contents, designated contents in said storage unit when the paper becomes unavailable.

Yamamoto discloses a quantity detecting unit for detecting the quantity of the paper said printing apparatus (see column 10 lines 62-65), and a storage unit storing data of said designated contents, designated contents in said storage unit when the paper becomes unavailable (see column 11 lines 1-14).

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Shidara, Walkingshaw & Yamamoto are combinable because they are from the same problem solving area, printing documents when certain conditions are met.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Yamamoto with the system of Shidara and Walkingshaw.

The suggestion/motivation for doing so would have been allow data to be received even if the printer has run out of paper therefore a user does not have to worry about losing any information that was desired.

Therefore, it would have been obvious to combine Yamamoto with Shidara and Walkingshaw to obtain the invention as specified in claims 4 and 16.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Shidara and Walkingshaw as applied to claim 1 above, and further in view of U.S. Patent No. 6476933 to Honma.

Walkingshaw discloses wherein the broadcast signals include a category code for specifying the category of said designated contents (see column 3 lines 40-52).

Shidara and Walkingshaw do not disclose expressly a print judging unit for storing said category code of said designated contents in association with the frequency that said designated contents of said category code is printed, and instructing said printing unit to print said designated contents of said category code having a high frequency.

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Honma discloses a print judging unit for storing said category code of said designated contents in association with the frequency that said designated contents of said category code is printed, and instructing said printing unit to print said designated contents of said category code having a high frequency (see column 9 lines 38-63).

Shidara, Walkingshaw & Honma are combinable because they are from the same field of endeavor, printing data from a stored area.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Honma with the system of Shidara and Walkingshaw.

The suggestion/motivation for doing so would have been to provide a user with an easy way to see how often a certain kind of document is printed and allow easy retrieval of such a document.

Therefore, it would have been obvious to combine Honma with Shidara and Walkingshaw to obtain the invention as specified in claim 5.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Shidara and Walkingshaw as applied to claim 14 above, and Walkingshaw discloses wherein the broadcast signals include a category code for specifying the category of said designated contents (see column 3 lines 40-52).

Shidara and Walkingshaw do not disclose expressly a print judging unit for storing said category code of said designated contents in association with the frequency that said designated contents of said category code is printed, and

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instructing said printing unit to print said designated contents of said category code having a high frequency.

Honma discloses a print judging unit for storing said category code of said designated contents in association with the frequency that said designated contents of said category code is printed, and instructing said printing unit to print said designated contents of said category code having a high frequency (see column 9 lines 38-63).

Shidara, Walkingshaw & Honma are combinable because they are from the same field of endeavor, printing data from a stored area.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Honma with the system of Shidara and Walkingshaw.

The suggestion/motivation for doing so would have been to provide a user with an easy way to see how often a certain kind of document is printed and allow easy retrieval of such a document.

Therefore, it would have been obvious to combine Honma with Shidara and Walkingshaw to obtain the invention as specified in claim 17.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show state of the art refer to U.S. Patent numbers 6433884 (Kawakami) and 6195170 (Mizutani et al.) and to JP Patent Application Publication number 11237966A (Nagahashi), (translation attached).

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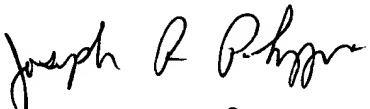
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (703) 305-1900. The examiner can normally be reached M-F 8:00am-4:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (703) 305-4712. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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